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EXAMINER

RAMOS FELICIANO, ELISEO

ART UNIT PAPER NUMBER

2617

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

10/655,959

Applicant(s)

TOO ET AL.

Examiner

Eliseo Ramos-Feliciano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-12 and 14-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 21 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Art Unit – Notice

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 21, 2006 has been entered.

Drawings

3. The drawings were received on March 21, 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1, 3-12 and 14-22** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding **claims 1 and 12**, they now require “operating functions not shown in the digital display”. This is subject matter not described in the original specification; therefore, new matter. Applicant has not pointed out where in the original specification support can be found for the outlined limitations.

Regarding **claims 3-11 and 14-22**, they depend on *claims 1 and 12*; therefore they contain same issues outlined above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1, 3-12 and 14-22** are rejected under 35 U.S.C. 102(b) as being anticipated by Want et al. (US Patent Number 5,825,675; hereinafter "Want").

Regarding **claim 1**, Want teaches a portable digital device (FIG. 4A) comprising:
at least two control devices for controlling at least two operating functions of the portable digital device (FIG. 4A, buttons 384, 386, 388; column 7, lines 21-28);

a digital display for displaying information (FIG. 4A display 380); and

a processor (FIG. 2, processor 180) for

rotating the information from a first orientation to a second orientation as a single entity (FIG. 3A to 6B; column 8, lines 11-23); and

remapping the at least two control devices to reverse their operating functions, including operating functions not shown in the digital display (for example, functions such as “UP” and/or “DOWN” depicted in Figures 4A-4B are not shown in the digital display 380, and are remapped

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once device is in inverted position), to allow for use of the portable digital device in both the first orientation and the second orientation (FIG. 4A and 4B; buttons 388 and 384; column 7, lines 43-58); wherein the at least two operating functions are selected from the group consisting of: skip forward, skip back, increase volume, decrease volume, menu display move to the right, and menu display move to the left (FIG. 3A to 6B; column 10, lines 18-39; column 7, lines 16-58) (for example, Want teaches the functions can be scrolling in any of four directions possible, column 10, line 24; therefore: menu display move to the right, and menu display move to the left as claimed).

Regarding **claim 2**, Want further teaches the limitations in FIG. 6A and 6B; column 10, lines 18-39.

Regarding **claim 3**, Want further teaches the limitations in column 10, lines 18-48.

Regarding **claim 4**, Want further teaches the limitations in column 10, lines 18-48.

Regarding **claim 5**, Want further teaches the limitations in column 10, lines 18-48.

Regarding **claim 6**, Want further teaches the limitations in FIGs. 4A and 4B.

Regarding **claim 7**, Want further teaches the limitations in FIGs. 3A-3D.

Regarding **claim 8**, Want further teaches the limitations in FIGs. 3A-3D.

Regarding **claim 9**, Want further teaches the limitations in FIGs. 3A-3D.

Regarding **claim 10**, Want further teaches a memory (FIG. 2, memory 172) containing a key map, a first table corresponding to the first orientation, and a second table corresponding to the second orientation (FIG. 5, tables in blocks 408 and 414).

Regarding **claim 11**, Want further teaches the limitations in column 9, lines 32-55 (the displayed information is processed as bit map).

Regarding **claim 12**, Want teaches a method for reorienting a portable digital device from a first orientation to is a second orientation comprising:

(a) rotating information for display on a digital display of a portable digital device from a first rotation position to a second rotation position (column 9, lines 32-36; FIG. 3A to 6B); and

(b) reversing (column 7, lines 44-47) at least two operating functions of at least two control devices of the portable digital device from a at least one operating function to at least one other operating function (column 9, lines 37-46); wherein the at least two operating functions, including operating functions not shown in the digital display (for example, functions such as “UP” and/or “DOWN” depicted in Figures 4A-4B are not shown in the digital display 380, and are remapped once device is in inverted position), are selected from the group consisting of: skip forward, skip back, increase volume, decrease volume, menu display move to the right, and menu display move to the left (FIG. 3A to 6B; column 10, lines 18-39; column 7, lines 16-58) (for example, Want teaches the functions can be scrolling in any of four directions possible, column 10, line 24; therefore: menu display move to the right, and menu display move to the left as claimed).

Regarding **claim 13**, Want further teaches limitations of the claim in (FIG. 6A and 6B; column 10, lines 18-39).

Regarding **claim 14**, Want further teaches the limitations in column 10, lines 18-48.

Regarding **claim 15**, Want further teaches the limitations in column 10, lines 18-48.

Regarding **claim 16**, Want further teaches the limitations in column 10, lines 18-48.

Regarding **claim 17**, Want further teaches the limitations in FIGs. 4A and 4B.

Regarding **claim 18**, Want further teaches the limitations in FIGs. 3A-3D.

Regarding **claim 19**, Want further teaches the limitations in FIGs. 3A-3D.

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Regarding **claim 20**, Want further teaches the limitations in FIGs. 3A-3D.

Regarding **claim 21**, Want further teaches a memory (FIG. 2, memory 172) containing a key map, a first table corresponding to the first orientation, and a second table corresponding to the second orientation (FIG. 5, tables in blocks 408 and 414).

Regarding **claim 22**, Want further teaches limitations of the claim in column 9, lines 32-55, FIG. 4A and 4B (displayed information is processed as bit map).

Response to Arguments

8. Applicant's arguments filed March 21, 2006 have been fully considered but they are not persuasive.

9. Applicant's arguments are generally directed to newly added limitations (see for example page 9, first full paragraph of the response). In response, these limitation have now been treated on the merits and a detailed explanation can be found above.

10. Applicant's argues that Want's processor 180 appears to be conventional microprocessor typically embodied in integrated circuit chips; and that Want cannot obtain the same advantages as the invention (see page 9, first paragraph; page 11 second full paragraph of the response). In response, Applicant has recognized another advantage(s) which would flow naturally from following the suggestion of the prior art. The claim is still anticipated.

11. Applicant's argues that Want does not teach or suggest remapped or reversed operating functions including skip forward, skip back, increase volume, decrease volume, menu display move to the right, and menu display move to the left (see page 10, fifth paragraph).

In response the Examiner respectfully disagrees because 1) these features are required in the alternative, and 2) as explained above, Want teaches the functions can be scrolling in any of

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four directions possible, column 10, line 24; therefore, at least: menu display move to the right, and menu display move to the left as claimed.

12. Applicant argues a particular definition of remapping (see page 12, first full paragraph).

In response, it is noted that this particular definition is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, as depicted in Figures 3A, 3C, 4A, 4C, etc., and corresponding description, Want teaches remapping as claimed.

Conclusion

13. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER

ERF/erf

May 26, 2006